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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,239	12/04/2001	Maria Pia Protti	9369 V/vmf	1842
466	7590	09/03/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			DAVIS, MINH TAM B	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/914,239

### Applicant(s)

PROTTI ET AL.

### Examiner

MINH-TAM DAVIS

### Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Applicant's election of group I, claims 1, 3-9 in paper of 01/05/04 is acknowledged.

After review and reconsideration, the restriction requirement of paper No: 9 or 11/04/03 is withdrawn and is replaced with the following restriction requirement.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 1, 3-5, drawn to peptides binding MHC class II molecules of SEQ ID Nos: 1-11.

**Group II**, claims 6-9, drawn to a method for inducing an immune response or the use of peptides of SEQ ID Nos: 1-11 for the preparation of an antitumor medicament.

**Group III**, claim(s) 2, drawn to antibodies directed to peptides binding MHC class II molecules of SEQ ID Nos: 1-11.

In addition, Groups I-III contain claims directed to more than one species of the generic invention:

Any one of SEQ ID Nos: 1-11 or any combination of SEQ ID NO:1-11.

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The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

It is noted that claim 1 is interpreted as peptides binding MHC class II molecules "comprising" the amino acid sequences selected from the group consisting of SEQ ID NOs:1-10 and 11.

It is further noted that the priority date of the claimed invention is determined to be 02/23/2000, in view that the parent application Italy MI99A000396 filed on 01/26/1999 is not translated into English and thus cannot be assessed. Applicant is invited to submit the translated parent application for priority date consideration.

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as groups I-III do not relate to a single general inventive concept because their corresponding technical feature is not a contribution over the prior art, as evidenced by the following references showing that the peptide comprising the amino acid sequence of SEQ ID Nos: 2-8, 10 or 11 of group I is known in the art, and therefore group 1 lacks novelty or inventive step, and does not make a contribution over the prior art.

US patent 5,965,535 teaches a MAGE-3 sequence of 314 amino acid, which comprises SEQ ID Nos: 2-8, 10-11, as shown by MPSRCH sequence similarity search (MPSRCH search report, us-09-914-239-(2-8, 10-11).std.ra, pages 1-2).

US2004053822A1 teaches the peptide of SEQ ID NO:1978, 2012, of 15 amino acids in length, which are exactly the same as the claimed SEQ ID No: 4 and 6,

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respectively , as shown by MPSRCH sequence similarity search (MPSRCH search report, us-09-914-239-4.siz.rapb, pages 1-2, us-09-914-239-6.siz.rapb, pages 1-2).

WO2001142267-A1, which has as a priority date 10 December 1999, teaches a sequences of 15 amino acids in length, and which are exactly the same as the claimed SEQ ID No: 4, 6 and 10, as shown by MPSRCH sequence similarity search (MPSRCH search report, us-09-914-239-4.siz.rag, page 2, us-09-914-239-6.siz.rag, page 2, us-09-914-239-10.siz.rag, page 2).

Thus groups I-III do not relate to a single general inventive concept.

A telephone call was made to Philip Dubois on 08/30/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

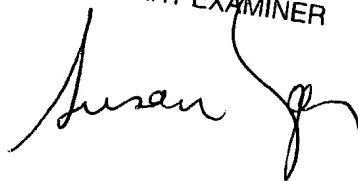
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SUSAN UNGAR, PH.D.  
PRIMARY EXAMINER



MINH TAM DAVIS

August 30, 2004